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for each transaction entry, using the received name of the transaction entry payee as the lookup name to determine whether the lookup name has an associated preferred name in the data structure, and if so, substituting the preferred name of the transaction entry payee for the received name of the transaction entry payee.

48. (New) The method of claim 47, wherein the lookup names are received from prior financial statements.

#### **REMARKS/ARGUMENTS**

Claims 26-48 are pending. Claims 26-46 were rejected under 35 U.S.C. § 103(a).

Claims 47 and 48 are newly added. The subject matter of claims 47 and 48 is fully supported by the specification as filed. No new matter has been added.

#### **Claim Rejections Under 35 U.S.C. § 103**

Claims 26-28, 33-34, and 40-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,842,185 (Chancey). Applicants respectfully traverse the rejection under 35 U.S.C. § 103.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A claimed invention is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1165 (Fed. Cir. 2000). In making this determination, the Examiner must carefully avoid the "tempting but forbidden zone of hindsight" in which "that which only the inventor taught is used against its teacher." *In re Dembicza*k, 50 USPQ2d 1614, 1616-1617 (Fed. Cir. 1999). A prima facie case of obviousness based on a combination of references requires a "clear and particular" showing of a teaching or motivation to combine the references. *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000).

Chancey does not disclose or suggest associating a received payee name with a corresponding preferred payee name in a data structure and as recited by independent claims 26, 33, and 40 of the present invention. Instead Chancey teaches, "With the statement displayed, the user may mark a transaction for further review with a '?', check and change categories, change the payee or the like." (Col. 5, lines 29-33.) Chancey teaches changing the "payee" (an entity), and does not teach changing the "payee name" (an attribute of the entity) unless the entity itself has changed. This teaches away from the claimed invention where the entity (i.e., the payee) remains the same while the attribute (i.e., the payee name) is changed. This distinction is significant because Chancey operates to change category names in response to a change in the payee (i.e., the entity), whereas the claimed invention operates to replace a received payee name with a preferred payee name of the **same** entity. (See, Col. 6, lines 11-19.) Thus Chancey does not operate to electronically "correct[...] payee names" as maintained by the Office Action of September 25, 2000 (page 3, §8).

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Additionally, Chancey does not disclose or suggest automatically replacing a received payee name (an attribute of the payee entity) with a preferred payee name (another attribute of the same payee entity) in response to an association of the preferred payee name with the associated payee name in a data structure. Instead, Chancey operates to automatically change category names in response to a change in the payee entity, and does not operate in response to an association in a data structure of the preferred payee name with the associated payee name. Chancey teaches away from the claimed invention by disclosing manual changes of the payee entity (which causes the change in category), rather than the instantiation of a data structure by which an association of attributes of a payee causes a change in names of the payee. Thus, applicants respectfully submit the cited reference was improperly relied upon to reject the claims of the present invention.

Claims 29-32, 36-39 and 43-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Chancey in view of Quicken 5 for Windows as evidenced by Home Banking with Quicken (Cummings). Applicants respectfully traverse the rejection under 35 U.S.C. § 103. The combination of Chancey in view of Cummings fails to disclose or suggest a motivated combination upon which claims 29-32, 36-39 and 43-46 read. In particular, the combination fails to disclose limitations of the claims discussed above from which claims 29-32, 36-39 and 43-46 depend. Thus Chancey in view of Cummings does not disclose a reasonable expectation of success and does not teach or suggest all the claim limitations.

For the reasons stated above, independent claims 26, 33, and 40 should not be rejected under 35 U.S.C. § 103(a) and are proposed to be allowable. Claims 27-32 (which depend from independent claim 26), claims 34-39 (which depend from independent claim 33), and claims 41-46 (which depend from independent claim 40) should not be rejected under 35 U.S.C. § 103(a)

for at least the reasons given for independent claims 26, 33, and 40, which are proposed to be allowable. Claims 47 and 48 are newly added and are also proposed to be allowable.

## CONCLUSION

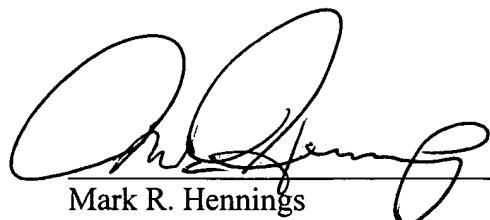
Applicants respectfully request favorable consideration for the allowance of claims 26-48. It is respectfully submitted that all claims in this case are patentable and that the application is in condition for allowance. Should any further aspects of the application remain unresolved, the Examiner is invited to telephone the Applicants' attorney at the number listed below. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Applicant(s) respectfully request(s) that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

MERCHANT & GOULD P.C.



Mark R. Hennings  
Registration No. 48,982  
Direct Dial: 206.342.6289

MERCHANT & GOULD P.C.  
P. O. Box 2903  
Minneapolis, Minnesota 55402-0903  
206.342.6200



VERSION WITH MARKINGS TO SHOW CHANGES MADE

**In the claims:**

New claims 47 and 48 have been added.

47. (New) A method for automatically renaming names of payees, wherein the names are received from the electronic transfer of financial data into a personal financial management program, comprising the steps of:

- storing in a data structure preferred names that are each associated with a lookup name;
- receiving a financial statement comprising one or more transaction entries, each transaction entry comprising a received name of a transaction entry payee and a transaction amount;
- for each transaction entry, using the received name of the transaction entry payee as the lookup name to determine whether the lookup name has an associated preferred name in the data structure, and if so, substituting the preferred name of the transaction entry payee for the received name of the transaction entry payee.

48. (New) The method of claim 47, wherein the lookup names are received from prior financial statements.